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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,477	07/14/2005	Pertti Lahteenmaki	BER-PT005	2844

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EXAMINER	
HOFFMAN, SUSAN COE	
ART UNIT	**PAPER NUMBER**
1655	

MAIL DATE	DELIVERY MODE
08/29/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/516,477	LAHTEENMAKI, PERTTI	
	Examiner	Art Unit	
	Susan Coe Hoffman	1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 August 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.

4a) Of the above claim(s) *6,8,11-13 and 15-25* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,7,9,10 and 14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *6/06; 7/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. The amendment filed August 15, 2007 has been received and entered.

2. Claims 1-25 are currently pending.

Election/Restrictions

3. Applicant's election of Group I, claims 1-15 and green tea for the species in the reply filed on August 15, 2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

4. Claims 6, 8, 11-13 and 15-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on August 15, 2007.

5. Claims 1-5, 7, 9, 10, and 14 are examined on the merits.

Claim Objections

6. Claims 1-5, 7, 9, 10, and 14 are objected to because of the following informalities: the claims do not begin with the appropriate phrasing. Independent claims should begin with "A" and dependent claims should begin with "The" as appropriate. Appropriate correction is required.

7. Claims 1 and 9 are objected to because of the following informalities: "taurine" is misspelled in the claims. Appropriate correction is required.

8. Claims 9 is objected to because of the following informalities: the claim does not end in a period. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 4, 5, 7, 10 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claim 1 is indefinite because the phrasing of the claim makes it unclear if the bark extract is required to contain flavonoids.

10. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 2 recites the broad recitation "bark

extract from a conifer", and the claim also recites "preferably pine bark" which is the narrower statement of the range/limitation. In addition, claim 4 recites the broad recitation a ratio of "2:1 - 6:1", and the claim also recites that the ratio is "preferably about 4:1" which is the narrower statement of the range/limitation. Furthermore, claim 14 recites the broad recitation "dry substance miscible with liquids," and the claim also recites "such as a powder, granule, or effervescent tablet" which is the narrower statement of the range/limitation. Thus, claims 2, 4, and 14 are indefinite.

11. Claim 9 is indefinite due to the use of the trademark "Pycnogenol." As discussed in MPEP 2173.05(u) "If the trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of the 35 U.S.C. 112, second paragraph. Ex parte Simpson, 218 USPQ 1020 (Bd. App. 1982). "

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. Claims 1-5, 7, 9, 10, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krotzer (WO 99/61038) in view of Thomas et al. (US Pat. No. 5,972,985).

Krotzer teaches a beverage composition that contains guarana, taurine, glucose, fructose, and green tea (see Table A, pages 15 and 20). The reference also teaches adding antioxidants to

this composition to protect the brain but does not specifically teach using pine bark pycnogenols or grape seed extract.

Thomas teaches a combination of antioxidants from US Pat. No. 4,698,360 and grape seed to protect the brain against free radial damage. According to applicant's specification, the product described in US '360 is pycnogenols (see page 5). Thus, Thomas teaches using pycnogenols and grape seed extract together as antioxidants that protect the brain. Based on this teaching of the properties of pycnogenols and grape seed extract, an artisan of ordinary skill would have reasonably expected that these ingredient would be beneficial to add to the composition taught by Krotzer. This reasonable expectation would be based on the teaching of Krotzer that it is desirable to use brain protecting antioxidants in the composition. Therefore, based on this reasonable expectation of successful results, an artisan would have been motivated to add pycnogenols and grape seed extract to the composition of glucose, fructose, guarana, taurine, and green tea taught by Krotzer.

The references also do not specifically teach adding the ingredients in the amounts claimed by applicant. The amount of a specific ingredient in a composition is clearly a result effective parameter that a person of ordinary skill in the art would routinely optimize. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Krotzer specifically teaches that the amounts of the ingredients can be varied. Thus, the art acknowledges that ingredient amount is a parameter that can be optimized. It would have been customary for an artisan of ordinary skill to determine the optimal amount of each ingredient to add in order to best achieve the desired results. Thus,

absent some demonstration of unexpected results from the claimed parameters, this optimization of ingredient amount would have been obvious at the time of applicant's invention.

The references also do not specifically teach that the drink composition is formulated as a powder, granule, or effervescent tablet. However, these forms are well known in the art as being appropriate forms for compositions that will be dissolved to form a drink. Thus, it would have been obvious for an artisan to use these forms while creating the beverage taught by the combination of Krotzer and Thomas.

13. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe Hoffman whose telephone number is (571) 272-0963. The examiner can normally be reached on Monday-Thursday, 9:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Susan Coe Hoffman
Primary Examiner
Art Unit 1655